



### REMARKS

Claims 1-6 are pending in this application and stand rejected. Amendments to claims 1-6 are presented above. Claims 7-9 are newly added in this response. Applicants have also presented amendments to correct various minor errors in the specification.

### REJECTIONS TO THE CLAIMS: 35 U.S.C. §103(a)

The Examiner rejects claims 1-6 under 35 U.S.C. § 103(a) as being unpatentable over Takemura (Japanese Patent JP404372057) in view of Jovicic et al. (U.S. Patent No. 5,855,007). Applicants respectfully traverse these rejections for the reasons presented below.

#### The Invention

The present invention relates to a consumer transaction facility for performing banking services. The present invention allows a user to specify and send transaction records to a destination electronic mail address, and also allows the user to choose whether to receive a paper receipt of the transaction. Thus, the present invention provides the user with the capability to store and manage transaction records from a personal computer and reduce wasteful use of paper.

#### The References

Takemura. Takemura relates to providing bank transaction records to a customer using a bank terminal such as a cash automatic transaction device. Takemura allows the customer to enter a FAX number as a destination for transaction information. When the FAX transfer destination number is registered in the customer's account, the transaction information is automatically transferred to the FAX number specified. See Takemura, Abstract.

Jovicic et al. Jovicic relates to an electronic coupon communication system for generating and redeeming product discount coupons over public computer networks such as the Internet. In Jovicic, an Internet coupon server displays available coupons to a user. The user selects a coupon,

and the server transmits the coupon to either the user's printer or to e-mail storage. The user is prompted to choose whether the coupon is to be mailed electronically. If the user elects not to mail the coupon electronically, then the server prompts the user to choose whether the coupon is to be printed. See Jovicic, Abstract; col. 8, lines 12-14; and col. 8, lines 32-35.

*The Present Claimed Invention Distinguishes Over the Prior Art*

Considering claim 1 of the present invention, claim 1 recites that "a destination electronic mail address for receiving a transaction record of a customer is able to be input." The Examiner asserts on page 2 of the Office Action that Takemura is able to input a destination address for a transaction record. However, Takemura appears to only allow a FAX number to be input, not an electronic mail address.

Claim 1, as amended, also recites that "it is selectable through said input means whether the transaction record is to be transmitted to the destination electronic mail address, issued in the form of a sheet, or both transmitted to the destination electronic mail address and issued in the form of a sheet." Thus, the present invention provides the user the ability to receive both an e-mail transmission and a paper receipt. The Examiner admits on page 2 of the Office Action that Takemura does not disclose "selectable as to whether the transaction record is to be transmitted to the destination electronic mail address and whether the transaction record is to be issued in form of a sheet." However, the Examiner asserts on page 2 of the Office Action that Jovicic teaches "selectable as to whether the coupon record is to be transmitted to the destination mail address and whether the record is to be issued in form of a sheet." Applicants submit Jovicic provides the ability for the user to choose one or the other of the options, but not both. Jovicic discloses that "[i]f the user elects not to mail the coupon electronically, Internet Coupon Server 124 prompts the user to input 424 whether the coupon is to be printed on the user's printing device 118," and that "[o]nce the user has chosen one of the available options, transaction is recorded in the coupon database 130" (Jovicic, col. 8, lines 32-35; col. 8, lines 37-38; and Fig. 4).

The Examiner also asserts that it would have been obvious “to modify Takemura’s invention by connecting to the electronic mail communication network which is readily available communication.” Applicants respectfully submit that the Examiner’s reason for combining the references is deficient. Because an electronic mail communication network is available does not mean that the ability to select how to receive transaction records has been provided. Further, “evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved ... The range of sources available, however, does not diminish the requirement for actual evidence.” Dembiczak, 50 USPQ2d 1617. The Examiner has not provided evidence that the teaching he proposes actually exists in the prior art.

The present invention provides the user with very flexible transaction receipt options. The present invention allows the user to receive either an e-mail transmission or a paper receipt, neither an e-mail transmission nor a paper receipt, or both an e-mail transmission and a paper receipt. Neither Takemura nor Jovicic nor their combination provide the ability for the user to choose to receive both an e-mail transmission and a paper receipt.

Furthermore, Jovicic fails to disclose the ability to select receipt of coupons by e-mail transmission and paper receipt because electronic coupons having money value. There is no motivation to permit output of a coupon to a plurality of output destinations because this can result in the double issuance of an item having money value. Thus, the combination of references do not teach or suggest the present invention.

As for the dependent claims, claim 3 has been rewritten to depend from claim 1. Thus, claims 2-6 depend from claim 1 and include all the limitations of claim 1 plus additional limitations that are not taught or suggested by the prior art. For example, claim 3 specifies that the destination electronic mail address may be stored, and that the user may choose whether to transmit to the stored address or to another electronic mail address. This feature is not taught by the cited references. Therefore, for at least this reason and the reasons set forth above with respect to claim 1, it is submitted that claims 2-6 patentably distinguish over the prior art.

Therefore, Applicants submit that claims 1-6 patentably distinguish over the prior art. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections under §103.

### New Claims

Claims 7-9 are newly added with this response to alternatively define the present invention. Claim 7 specifies a consumer transaction facility that allows a user to select to receive a transaction receipt both at a destination electronic mail address and as a paper receipt. Claim 8 recites "selecting whether to receive a transaction receipt both at a destination electronic mail address and as a paper receipt." Claim 9 recites "providing options to receive a transaction receipt at the destination electronic mail address, as a paper receipt, or to receive a transaction receipt both at a destination electronic mail address and as a paper receipt." These features are not taught or suggested by the cited references. Thus, for at least the reasons presented above, Applicants submit claims 7-9 patentably distinguish over the prior art. Accordingly, Applicants respectfully request allowance of the new claims.

### CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding rejections, the application is submitted to be in condition for allowance, which action is earnestly solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Serial No. 09/241,083

Docket No. 1080.1071/CJG

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 7/18/00

By: C. Joan Gilsdorf  
Christine Joan Gilsdorf  
Registration No. 43,635

Suite 500  
700 Eleventh St., N.W.  
Washington, D.C. 20001  
(202) 434-1500